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EXAMINER

OBEID, MAMON A

ART UNIT	PAPER NUMBER
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3621

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05/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/990,605	Applicant(s) MONTGOMERY ET AL.	
	Examiner MAMON OBEID	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/12/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 168-179 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 168-179 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/06/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Acknowledgements

1. This communication is in reply to the claims amendment filed February 12, 2009.
2. Claims 1-167 have been canceled.
3. Claims 168- 179 are pending and have been examined.

Drawings Objection

4. The drawings are objected to under 37 CFR 1.83(a) because they are incomplete. 37 C.F.R. §1.83(a) reads as follows:

The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawing.

5. The Applicants are requested to submit the necessary drawings that illustrate the claimed invention (e.g., from claim 168 "a tracking identification string allocation module" and a "tracking number request module" is not illustrated).

Information Disclosure Statement

6. The information disclosure statement ("IDS") filed February 6, 2009 fails in part to comply with 37 C.F.R. §1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately

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from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement.

7. In the IDS, the foreign reference Sonedaka (identified as JP 02199939 A) and titled as "System for verifying opposite party" was incorrectly listed as a non-patent literature (NPL). While the Sonedaka reference has been considered, in order to have the reference listed on the patent issued from this application, Applicant is required to list this reference as a foreign reference in the IDS (e.g. form 1449) in the "foreign patent documents" section.

Specification

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1) and MPEP § 608.01(o).

Correction of the following is required:

- a. a "tracking identification string allocation module" in at least claim 168;
- b. a "tracking number request module " in at least claim 177;
- c. a "USPS delivery confirmation code" in at least claim 178.

Claim Rejections - 35 USC § 112-1st

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 179 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

11. Claims 179 recites: “wherein the unique tracking identification string is a USPS delivery confirmation code” which lack support in Applicants’ original specification. If Applicants believe otherwise, Applicants are requested to provide sufficient evidence in support thereof. Upon receiving said evidence, this rejection will be withdrawn.

Claim Rejections - 35 USC § 112-2nd

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 168- 179 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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14. In claim 168, it is still unclear whether Applicants are claiming the subcombination of a “vendor-controlled centralized postage-issuing computer system” or the combination of a “vendor-controlled centralized postage-issuing computer system”, plurality of end user computers, and a “USPS computer system”. If it’s Applicants’ intent to claim only the subcombination, the body of the claims must be amended to remove any positive recitation of the combination. If it’s Applicants’ intent to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim. For the later, the Examiner recommends claiming “A system.”

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 168- 179 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gordon et al, (U.S. Patent No. 6,527,178 B1) (“Gordon”) in view of Giles et al (U.S. Patent No. 6,996, 546 B1) (“Giles”).

17. **As per claim 168:** Gordon discloses:

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- d. a communications interface (e.g. communication channel) remotely coupled with a plurality of end user computers (e.g. “mailer **12**”) and a USPS computer system (“postal authority **10**”); data processing circuitry (e.g. central processing unit) communicatively coupled with the communications interface (column 4, lines 30- 46; figure 1 and related text);
- e. local memory (e.g. database) communicatively coupled with the data processing circuitry, the local memory comprising a database and a plurality of modules executable by the data processing circuitry (column 4, lines 26-46), the plurality of modules (e.g. software) comprising:
- f. a tracking identification string allocation module (e.g. master log database **20**”) programmed to allocate a unique tracking identification string (e.g. serial or transaction number) to one of the end user computers in response to a tracking identification string request from the one end user computer (column 5, lines 21- 33; figures 4, 5 and related text);
- g. a postage indicium generation module (e.g. “server **22**” or “postal authority **10**”) programmed to generate a unique postage indicium (e.g. postage indicia) in response to a unique postage indicium request from the one end user computer (column 5, lines 21- 33; column 6, lines 1- 6);
- h. an indexing module (e.g. master log database **20**”) programmed to index the unique postage indicium by association with the unique tracking identification string (column 5, lines 21- 33; figures 4, 5 and related text); and

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i. a database management module (e.g. master log database **20**) programmed to store the indexed unique postage indicium in the database and programmed to retrieve data corresponding to the indexed unique postage indicium from the database in response to a USPS postage indicium request, from the USPS computer system, comprising the unique tracking identification string (column 8, lines 3-14).

18. Gordon further discloses a mailer's computer **12** transmits a request for postage indicia including payment information (e.g. payment request) to the postal authority **10**. Once the request for postage has been fully processed within the postal authority, the cryptographically secured or plain text postage indicia is transmitted to the mailer (column 4, lines 30-65).

19. What Gordon does not specifically disclose is allocate tracking identification string (e.g. serial, transaction number or code) in response to an end user tracking string request distinguishable from the postage indicium request. However, Giles discloses a first and second system. The first system requests the second system for a transaction digital receipts (e.g. tracking string or transaction identification code) and transmits a transaction amount or number of units requested and a payment method (e.g., account number or credit card number) to the second system. The second system checks the customer's account for available funds. If funds are available, the second system generates a digital receipt for the transaction including a digital signature, and

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stores all appropriate data including, for example, key(s) for a digital signature encoded in the digital receipt, the transaction identification code, and the transaction amount or the number of units authorized. The second system then sends the digital receipt to the first system. The first system then generates an indicia including the digital receipt generated by the second system (column 3, lines 16- 55).

20. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gordon teachings to include a transaction-code generating module/system distinguishable from an indicia generating module/system, disclosed by Giles, for load balancing which is a technique used to spread work load among many processes, computers, networks, disks or other resources, so that no single resource is overloaded. Another motivation would be to outsource jobs such as payment services, thereby allowing an outsourcing company to focus on other business issues while having the details taken care of by outside experts. This means that a large amount of resources and attention, that might fall on the shoulders of management professionals, can be used for more important, broader issues within the company.

21. **As per claim 169:** Gordon further discloses wherein the unique tracking identification string is unique within the USPS for at least one year (column 3, lines 13-26).

22. **As per claim 170:** Gordon further discloses wherein the data corresponding to the unique postage indicium comprises data representative of one or more items

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selected from the group consisting of postage amount, date and time of postage information creation, service class, optional data advance, and delivery zip code (column 4, line 65- column 5, line 5).

23. **As per claims 171-172:** Gordon further discloses

j. a digital signature generation submodule programmed to generate a digital signature (column 4, line 65- column 5, line 20).; and

k. an association submodule programmed to associate the digital signature with the data corresponding to the indexed unique postage indicium (column 5, lines 21- 33).

24. Claim 173 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon in view of Giles and further in view of Applicants Admitted Prior Art ("AAPA").

25. **As per claim 173-174:** the combination Gordon/ Giles further discloses postal authority **10** including a processor , wherein the postal authority signing (e.g. digital signature) the indicia using a private key; Gordon does not expressly discloses wherein the data processing circuitry comprises a physically secure coprocessor device. However, Applicants admits that coprocessor devices (e.g. FIPS-140 Level 4 IBM 458 co-processor) are old and well know in the art (Application publication: ¶ [0102]).

26. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify combination Gordon/ Giles' teachings to

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include a coprocessor, admitted prior art, to provide extra security against outsider and insider attacks thereby producing an authenticated indicia. In other words, a digital signature is secure in that the path from the processor to the display is known to be secure and therefore, what is presented to the user is known to accurately reflect that which is digitally signed. Even when the electronic indicia is provided from outside of the co-processor module, the received indicia is displayed and digitally signed within the co-processor module and therefore, a user, if they properly review the indicia before authorizing digital signing thereof is assured that what they reviewed is what was actually signed (see e.g. Beletski U.S. Patent Application Publication No. 2002/0157003 at ¶ [0047]).

27. **As per claim 175:** the combination Gordon/ Giles further discloses communications module executable by the data processing circuitry, the communications module programmed to receive, over the communications interface, the unique postage indicium request from the one end user computer, the tracking identification string request from the one end user computer, and the USPS postage indicium request from the USPS computer system, the communications module being further programmed to transmit, over the communications interface, the unique tracking identification string to the one end user computer to allow the one end user computer to affix the unique tracking identification string to a mailpiece (column 4, lines 30- 46; figures 4, 5, 7, 8 and related text).

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28. **As per claim 176:** Gordon further discloses wherein the communications interface is remotely coupled with a centralized master tracking computer system with the USPS computer system, the communications module being further programmed to transmit a vendor request for the unique tracking identification string to the centralized master tracking computer system and programmed to receive the unique tracking identification string from the centralized master tracking computer system in response to the vendor request for the unique tracking identification string (column 4, lines 30- 46; figures 4, 5, 7, 8 and related text).

29. **As per claim 177:** Gordon further discloses a tracking number request module executable by the data processing circuitry and programmed to generate the vendor request for the unique tracking identification string (column 4, lines 30-65).

30. Claim 177 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon in view of Giles and further in view of Applicants Admitted Prior Art.

31. **As per claim 177:** the combination Gordon/ Giles further discloses an indicia transaction or serial number. The combination Gordon/ Giles does not specifically disclose a USPS delivery confirmation code. However, Applicants admits that the use of a USPS delivery confirmation code is old and well know in the art (Application publication: ¶ [0088]).

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32. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the combination Gordon/ Giles' teachings to include a USPS delivery confirmation code to track a delivery status of a mail piece thereby enabling customers to know the time when a piece of mail would be delivered so that they can adjust their schedule or plans accordingly.

Response to Arguments

33. Applicants' arguments with respect to claim 168-179 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

34. Applicants' amendment filed February 12, 2009 necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

35. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is cited in the Notice of References Cited (form PTO-892).

37. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is not a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted).

Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has not been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

38. Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the

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Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

39. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mamon Obeid whose telephone number is (571) 270-1813. The Examiner can normally be reached on Mon-Fri 9:30 AM- 6:00 PM.

40. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mamon Obeid
Examiner
Art Unit: 3621
May 27, 2009

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621